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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,867	12/14/2001	Tomas R. Szabo	660088.415	6700

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER	
O SULLIVAN, PETER G	

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,867	SZABO ET AL.	
	Examiner	Art Unit	
	Peter G O'Sullivan	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-62* is/are pending in the application.

4a) Of the above claim(s) *3,8,9,13,18,27,28,30,35,40,41,45,50,59,60 and 62* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-7,10-12,14-17,19-26,29,31-34,36-39,42-44,46-49,51-58,60 and 61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 1-62 are pending in this application which should be reviewed for errors. In response to the restriction requirement, applicants elected Group I, claims 1-62, drawn to compounds containing ligands. Upon the further requirement for the election of a single disclosed species, applicants elected the species of compound 1-6. Applicants' compounds having a glycinate ligand wherein A is C(=O), N-hydrogen substituted amido or carbonylamino, carbonyl, or amino and wherein R5 is hydrogen or optionally substituted alkyl or aralkyl, are examined therewith with all other compounds and claims 3, 8, 9, 13, 18, 27, 28, 30, 35, 40, 41, 45, 50, 59, 60 and 62 held withdrawn from consideration. The examiner requests applicants send a copy of their reference, AR, missing from the case, so it may be considered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 10, 14, 21, 24-26, 29, 31-34, 42, 46, 53-58 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Goel et al., US 5,929,064, disclose anticipating 7,12-diethyl and diethenyl 2,18-dipropanoato cobalto porphine compounds in the examples.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 4-7, 10-12, 14-17, 19-26, 29, 31-34, 36-39, 42-44, 46-49, 51-58, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goel et al., US 5,929,064, in view of Bommer et al., US 4,675,338, Platzek et al., US 6,136,841, and Niedballa et al., US 5,275,801.

Goel et al. disclose amino acid complexes of cobalt mesoporphyrin and protoporphyrin useful in the treatment of obesity and cancer given by their formulae I and II (s. Col. 2 and 3). Goel et al. disclose anticipating 7,12-diethyl and diethenyl 2,18-dipropanoato cobalto porphine compounds in the examples as well as injection of their compounds to control obesity (s. Col. 9, bottom to Col. 11, top). The instant invention differs from the teaching of Goel et al. in that the 2, 18 groups may be other than the propanoic acid groups shown. Bommer et al., for similar compounds used in the treatment of cancer, disclose the equivalency of propanoic acids to their alkyl or benzyl esters (s., e.g. Def. for R6, R7 and R in Col. 6, ll. 43-58.). Platzek et al., for similar anti-cancer compounds, show the equivalency of ketone, amido, aminocarbonyl and ester

substituted alkyl groups to acid substituted alkyl groups (s. Col. 3, ll. 31-50, Def. for R2 and R3). Additionally, the length of the alkyl moiety attached to the porphyrin ring may vary in that the group, A, may be of varying length. Niedballa et al. is relied on to additionally disclose the equivalency of amido to acid as substituents of alkyl moieties of similar anti-cancer agents. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of the cited references, to make applicants' compounds wherein the length of the 2,18 substituents varies and wherein the substitution is not only acid, but ester, ketone, amido, aminocarbonyl, etc. and to expect to obtain compounds useful in treating obesity and cancer.

No claim is allowed.

Any inquiry concerning this communication should be directed to Peter G O'Sullivan at telephone number (571)272-0642.

PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200